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Docket No.: 9999-100US01

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Arlene Balto

Serial No.: 09/773,334

Art Unit: 3643

Filed: January 31, 2001

Examiner: Timothy D. Collins

For: ANIMAL TREATMENT/CONFINEMENT  
APPARATUS

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APPEAL BRIEF

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

This is an appeal from the Final Rejection mailed June 17, 2003. The Notice of Appeal was timely filed on August 18, 2003. This Appeal Brief is being filed on the first Monday following the two-month due date, October 18, 2003, which fell on a Saturday. This Appeal Brief is being submitted in triplicate. Please charge the \$165.00 fee for filing the Appeal Brief, and any additional fees that may be required, to Deposit Account No. 50-1778. A duplicate copy of this first page of the Appeal Brief is attached for your convenience for charging the fee to the Deposit Account.

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being deposited with the United States Post Service, as First Class Mail, in an envelope addressed to: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 20, 2003.

By: Angela Watson  
Angela Watson

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## **REAL PARTY IN INTEREST**

The real party in interest is the party named in the caption: Arlene Balto of St. Anthony, Minnesota.

## **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

## **STATUS OF CLAIMS**

Claims 1-3, 6-7, 9-11 and 14-19 are on appeal in this case. Claims 1-3, 6-7, 9-11 and 14-19 stand rejected under 35 U.S.C. § 103.

Claims 1 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gullino et al. (US 3,897,751) in view of Chung (US 4,279,361).

Claims 2, 3, 7, 9-10, and 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gullino et al. (US 3,897,751) in view of Chung, and further in view of Thrun (US 6,349,675).

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gullino et al. (US 3,897,751) in view of Chung (US 4,279,361), and further in view of Peterson (US 5,988,110).

Claims 16-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gullino et al. (US 3,897,751), in view of Chung (US 4,279,361), and further in view of Carlin (US D297,471).

## **STATUS OF AMENDMENTS**

The claims have not been amended under 37 C.F.R. § 1.116. The claims stand as amended in the Amendment filed March 13, 2003.

## **SUMMARY OF THE INVENTION**

The invention generally relates to an animal confinement device. The animal confinement device includes a housing sized to receive an animal, such as a cat. See Appellant's disclosure, page 1, lines 20-21; page 3, lines 10-14. The animal confinement device further includes features to aid in therapeutic treatment of the animal.

In some embodiments, the animal confinement device includes an administration apparatus, which aids in therapeutic treatment by the provision of fluids, medications and other supportive care therapy. See Appellant's disclosure, page 1, lines 16-20; page 4, line 8 to page 6, line 2; see also FIGS. 1-3. The administration apparatus, which is coupled to the housing (12, 14, 16, 18, 20) comprises a fluid container support (32, 36), used to hold fluids (50) for gradual administration, or a syringe cradle (34), used to support a syringe (54) allowing more rapid administration, or both. The syringe cradle (34) is coupled either to the housing (12, 14, 16, 18, 20) or to the fluid container support (32, 36). The fluid container support (32, 36) may be crook-shaped. See Appellant's disclosure, page 4, lines 18-19; FIGS. 1-3.

In other embodiments, the animal confinement device includes at least two top panels (22, 24) hingedly (26, 64) coupled to the housing (20). See Appellant's disclosure, page 2, lines 4-18; page 3, lines 16-19; page 6, line 7 to page 7, line 6; see also FIGS. 1, 3. The top panels (22, 24) selectively positionable to cover at least a portion of a top opening of the housing (12, 14, 16, 18, 20). Furthermore, the top panels (22, 24), when in a closed position, cover less than one hundred percent of the top opening. See Appellant's disclosure, page 2, line 7; page 6, lines 16-17; FIG. 3. Because the panels (22, 24) cover less than one hundred percent of the top opening, the animal's handler (62) has access to the animal (60), allowing the handler (62) to administer medicine or fluids and to provide a comforting touch. See Appellant's disclosure, page 2, lines 6-8; page 6, lines 19-22; FIG. 3. At the same time, the panels prevent the escape of the animal (60) from the animal confinement device. See Appellant's disclosure, page 2, lines 8-9; page 6, lines 7-15; FIG. 3.

The animal confinement device may also include other features. The animal confinement device may include clasps (66, 68) to secure the top panels (22, 24) in a closed position. See Appellant's disclosure, page 2, lines 5-6; page 6, lines 10-15. The front panel (12) of the housing may include a window (28) with a grate (30). See Appellant's disclosure, page 2, lines 10-12; page 4, lines 1-7.

## ISSUES

Claims 1-3, 6-7, 9-11 and 14-19 stand rejected under 35 U.S.C. § 103 on the basis of the references cited above. The issues on appeal are:

1. Whether claims 1 and 11 are unpatentable under 35 U.S.C. § 103 over Gullino et al. (US 3,897,751) in view of Chung (US 4,279,361);
2. Whether claims 2, 3, 7, 9-10, and 14-15 are unpatentable under 35 U.S.C. § 103 over Gullino et al. (US 3,897,751) in view of Chung, and further in view of Thrun (US 6,349,675);
3. Whether claim 6 is unpatentable under 35 U.S.C. § 103 over Gullino et al. (US 3,897,751) in view of Chung (US 4,279,361), and further in view of Peterson (US 5,988,110); and
4. Whether claims 16-19 are unpatentable under 35 U.S.C. § 103 over Gullino et al. (US 3,897,751), in view of Chung (US 4,279,361), and further in view of Carlin (US D297,471).

### **GROUPING OF CLAIMS**

The following grouping of claims is set out solely for the purpose of expediting this Appeal.

Group I: Claims 1 and 11.  
Group II: Claims 2, 3, 7, 9-10, and 14-15.  
Group III: Claim 6.  
Group IV: Claims 16-19.

The claims of Groups I, II, III and IV are separately patentable and do not stand or fall together.

### **ARGUMENTS**

In the final Office Action, the Examiner rejected claims 1-3, 6-7, 9-11 and 14-19 under 35 U.S.C. § 103(a). In particular, the Examiner rejected claims 1 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Gullino et al. (US 3,897,751) in view of Chung (US 4,279,361). The Examiner also rejected claims 2, 3, 7, 9-10, and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over Gullino et al. (US 3,897,751) in view of Chung, and further in view of Thrun (US 6,349,675). The Examiner further rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Gullino et al. (US 3,897,751) in view of Chung (US 4,279,361), and further in view of Peterson (US 5,988,110). In addition, the Examiner rejected claims 16-19

under 35 U.S.C. § 103(a) as being unpatentable over Gullino et al. (US 3,897,751), in view of Chung (US 4,279,361), and further in view of Carlin (US D297,471).

*Use of Hindsight*

The Examiner began the Detailed Action section of the Final Office Action by addressing the Applicant's/Appellant's argument that the Examiner had been applying a hindsight-based analysis. The Examiner stated:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). (Detailed Action, p. 2)

The Examiner's reliance upon In re McLaughlin is improper for two reasons. First, In re McLaughlin is not an accurate statement of the law, and it was error for the Examiner to apply a hindsight-based analysis based upon In re McLaughlin. This ground alone is sufficient for reversal. Second, even if the hindsight standard of In re McLaughlin were still good law, the Examiner did not comply with that standard when rejecting the Applicant's claims. In particular, the Examiner combined features from disparate references based upon the Applicant's disclosure, and not based upon any evidence in the record.

The Examiner asserted that a hindsight-based analysis is permitted, so long as the hindsight-based analysis takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure. The current law pertaining to a hindsight-based analysis is that it is forbidden. In re Dembiczak, 50 USPQ2d 1614, 1616-17 (Fed. Cir. 1999); Al-Site Corp. v. VSI International, Inc., 50 USPQ2d 1161, 1171 (Fed. Cir. 1999).

In particular, it is improper for an Examiner to pick and choose disclosures from the prior art to construct the Applicant's claimed invention. In re Gorman, 18

USPQ 2d 1885, 1888 (Fed. Cir. 1991) (“It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.”); In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

The correct legal standard for obviousness is well-established. The Examiner must determine whether the prior art provides a “teaching or suggestion to one of ordinary skill in the art to make the changes that would produce” the claimed invention. In re Chu, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995). A *prima facie* case of obviousness is established only when this burden is met, and the Examiner bears the burden of establishing a *prima facie* case of obviousness. In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

In a proper obviousness determination, the prior art must give a reason or motivation for making the claimed invention. In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In re Lee emphasizes that evidence of motivation to combine references is not a trivial requirement, but is rather the best defense against a hindsight-based analysis. *Id.* In re Dembiczak, 50 USPQ2d at 1617, underscores that combining prior art references without evidence of a suggestion, teaching or motivation to combine references simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability, and this is the “essence of hindsight.” A rigorous application of the requirement for a showing of the teaching or motivation to combine is “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis.” *Id.*

Furthermore, In re Lee and In re Dembiczak further emphasize the importance of creation of an evidentiary record that supports a conclusion of obviousness. In re Lee, 61 USPQ2d at 1433-34; In re Dembiczak, 50 USPQ2d at 1617. The findings must be based upon evidence in the record, not upon the subjective belief of the Examiner. See In re Lee, 61 USPQ2d at 1434 (the factual inquiry into whether to combine references “must be based on objective evidence in the record”); In re Dembiczak, 50 USPQ2d at 1617 (“The range of sources available, however, does not diminish the requirement for actual evidence.”).

The Examiner has admitted that no motivation to combine is found in the references or any evidence of record. Instead, the Examiner asserted that the motivation to combine was based upon general knowledge:

In this case, the motivation to combine is found in knowledge generally available to one of ordinary skill in the art.... (Detailed Action, p. 3)

The Examiner has admitted a legal error that justifies reversal. If there are deficiencies in the evidentiary record, the deficiencies cannot be cured by general conclusions such as "general knowledge" or "common sense." In re Lee, 61 USPQ2d at 1434; see also In re Dembiczak, 50 USPQ2d at 1617 (it was error not to make particular factual findings regarding the locus of the suggestion, teaching or motivation to combine references).

A patentable invention may arise from a combination of elements found in the prior art. It is therefore not sufficient for the Examiner merely to identify individual components of an invention in multiple references. E.g., Ruiz v. A.B. Chance Co., 57 USPQ2d 1161, 1167 (Fed. Cir. 2000). The Examiner must demonstrate that a skilled artisan, with no knowledge of the Applicants' claimed invention, would have selected the components for combination in the manner claimed. In re Kotzab, 55 USPQ2d 1313, 1316-18 (Fed. Cir. 2000). It is not sufficient for the Examiner to assert that separate elements of the claimed invention exist in the prior art, or that the elements in different references could be combined, or that there is an apparent need for combination of the elements, or that elements may be substitutes for one another. Ruiz v. A.B. Chance Co., 57 USPQ2d at 1167. To establish a prima facie case of unpatentability, the Examiner must provide evidence showing a reason, suggestion or motivation to combine.

The Applicant requests that the rejection of all claims be reversed because the Examiner applied the improper legal standard when rejecting the Applicant's claims. In particular the Examiner deemed that a degree of hindsight as necessary, when under the current law, hindsight is forbidden.

The Examiner further erred by expressly using the Applicant's own disclosure as a basis for the motivation to combine references. The Examiner stated:

In response to applicant's argument that there must be motivation to combine, the examiner maintains that the motivation to

combine is stated in the below rejections, in the statements which state why these combinations would be made. It is also noted that the applicant seems to have seen these reasons and admits that these reasons are advantages. (Detailed Action, p. 2, emphasis supplied)

This stunning remark by the Examiner is clear error and is grounds for reversal. The Examiner has it completely backward. It is up to the Examiner to make an evidentiary record supporting a finding of motivation. The Examiner cannot take the Applicant's own disclosure and say that the Applicant's own disclosure constitutes an admission that there is a motivation. "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to use that which the inventor taught against the teacher." In re Lee, 61 USPQ2d at 1434 (quotation and citation omitted).

As will be discussed below, the Examiner blatantly and without evidentiary support recited advantages from the Applicant's own disclosure as motivations to pick and choose features from various references to come up with the Applicant's invention. This was clearly erroneous.

Because the Examiner applied clearly erroneous standards in rejecting the Applicant's claims, the Applicant respectfully request that the rejection be reversed.

#### *Claims 1, 11*

Claims 1 and 11 recite an apparatus comprising a housing sized to receive an animal, a fluid container support coupled to the housing, and a syringe cradle coupled to at least one of the housing and the fluid container support. Claims 1 recites the housing as comprising a front panel, a rear panel, a bottom panel, and two side panels. Claim 11 recites the housing as being sized to receive an animal and to confine the animal during therapeutic treatment.

In the Final Office Action, the Examiner rejected claims 1 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Gullino (US 3,897,751) in view of Chung (US 4,279,361). According to the Examiner, Gullino discloses a housing 10 comprising a front panel 14, a rear panel 14, a bottom panel 14, and two side panels 14, and a fluid container support 34 coupled to the housing, and that the housing is used during therapeutic treatment. The Examiner admitted, however, that Gullino fails to disclose a syringe cradle coupled to the housing or the fluid container as

recited in claims 1 and 11, but stated that Gullino does disclose medication disseminated to the animal via members 37, 40, 21, and 38. The Examiner further declared that Chung discloses a syringe cradle.

The Examiner asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Chung to the invention of Gullino to have the syringe means in a stable position in a stable condition and near the animal to be treated. It would further have been obvious to the ordinary skilled artisan, the Examiner continued, to attach the cradle to the housing or the fluid container. The Examiner asserted that the syringe disclosed by Gullino is in very close proximity to the cage and it would be intuitive to attach it to the cage or fluid container, and to allow for easier handling and transportation.

The Examiner's analysis was in error.

There is no motivation whatsoever to take features from Chung and put them on a Gullino device. Gullino describes an animal cage for use in a laboratory or medical environment (Gullino, col. 1, lines 6-7). The Examiner asserts that Gullino discloses a syringe, saying "number 31 is a syringe and number 38 is a needle." This assertion is plainly in error. Number 31 in Gullino refers to an infusion pump (Gullino, col. 3, lines 10-11). Gullino does not mention a "syringe" in any context. Moreover, an infusion pump is not a syringe, which is a manually operable device. The infusion system in Gullino is not manually operable, as Gullino describes an infusion that is continuous over "days or even weeks." (Gullino, col. 1, lines 45-46).

The Chung apparatus, in contrast to the Gullino apparatus, is not used for treatment of any living thing, animal or human. Rather, the Chung device includes a clamping structure for extruding gels from gel tubes in a controlled manner in a laboratory setting. The clamping structure holds a syringe that is operated with a pressure plate driven by a turning handle coupled to a threaded shaft. Turning the handle will rotate the threaded shaft, causing the pressure plate to drive water into a gel tube to extrude the gel from the gel tube (Chung, cols. 1-2).

"In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must be in the field of the applicant's endeavor, or, if not, reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 24 USPQ2d at 1445. The Examiner asserted that Chung is analogous art because "Chung teaches of a syringe holder and dispensing fluids, and

also the Gullino et al reference teaches of using a syringe for dispensing fluids. Therefore it is analogous and is related."

The Examiner was legally wrong. Basically, the effect of the Examiner's position is that the Oetiker rule is meaningless, and a reference need not be in the field of the Applicant's endeavor nor reasonably pertinent to the particular problem with which the inventor was concerned.

Chung does not satisfy either Oetiker criterion. First, Chung is simply not directed to the field of the Applicant's endeavor. Chung is not concerned with administration of fluids to a living thing in general, or to an animal in particular. Second, Chung is not reasonably pertinent to the particular problem with which the inventor was concerned. Chung is directed to the problem of removing gels from glass tubes, without reaming the gel with needles and potentially damaging the tubes (Chung col. 1, lines 21-27). The Applicant's claimed invention is not at all concerned with cleaning gel out of tubes in such a fashion so as not to damage the tubes. The Applicant's concern for animal care is not mentioned in Chung at all.

In addition, there would be no motivation for one skilled in the art to add a Chung clamping frame to a Gullino device, because, as noted above, there is simply no syringe in Gullino. Because the animal in the Gullino device receives fluids without a syringe, there would be no motivation for one skilled in the art to add a Chung clamping frame to the Gullino device. There is no member disclosed in Gullino that could mate with the Chung device, and placing the Chung device anywhere on the Gullino device would be completely superfluous. Gullino and Chung disclose no motivation for making such a superfluous combination of features.

The Examiner concluded that the motivation for combining a Chung device with a Gullino device "is that it will hold the syringe steady and stable as taught in Chung because Chung does not want the syringe to move, therefore it teaches of holding the syringe still while forcing fluid out, which is relevant to Gullino et al, which forces fluid out of the syringe of Gullino et al." This rationale is nonsense, and constitutes no motivation at all. There is nothing at all in Gullino that suggests that motion of the infusion pump is a problem, or that the infusion pump needs or would benefit from a Chung device to keep the infusion pump from moving, or that the Chung device could physically mate to the infusion pump.

The Examiner further asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Chung to the invention of Gullino to have the syringe means in a stable position in a stable condition and near the animal to be treated. It would further have been obvious to the ordinary skilled artisan, the Examiner said, to attach the cradle to the housing or the fluid container. The Examiner stated that the syringe disclosed by Gullino is in very close proximity to the cage and it would be intuitive to attach it to the cage or fluid container, and to allow for easier handling and transportation. This would also make the device portable and would keep the syringe from falling or moving around and pulling on the animal or out of the animal.

The Examiner cited no evidence in support of these assertions. Without evidence, these assertions cannot support a finding of unpatentability. In re Lee, 61 USPQ2d at 1434; In re Dembiczak, 50 USPQ2d at 1617. In particular, a conclusory statement that a motivation would be "intuitive" is the kind of conclusory statement deemed improper in In re Lee, 61 USPQ2d at 1434.

And once again, the motivation is nonsense. There is no evidence in the record that the Gullino infusion pump would benefit in any way from a Chung device. There is noting in Gullino to suggest that the Gullino device would benefit from being more portable, and there is nothing in Chung to suggest that the Chung device would improve portability or aid an animal.

The Applicant has directed these arguments to claims 1 and 11. The Applicant notes, however, that claims 2, 3, 6, 16 and 17 depend upon claim 1, and claims 14, 15, 18 and 19 depend upon claim 11. Because the rejection of claims 1 and 11 was improper, the rejections of claims 2, 3, 6, and 14-19 were improper as well. Furthermore, the above discussion has a bearing upon rejections of claims 9 and 10, which recite a fluid container support and a syringe cradle.

Because the rejections of claims 1 and 11 under 35 U.S.C. § 103(a) were erroneous, the Applicant respectfully request that the rejection of these claims be reversed. The Applicant further respectfully requests that the rejections of claims 2, 3, 6, and 14-19 be reversed as well.

*Claims 2, 3, 7, 9-10, and 14-15*

In the Final Office Action, the Examiner further rejected claims 2, 3, 7-10 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Gullino in view of Chung, and further in view of Thrun (US 6,349,675). The Examiner also rejected claim 15, citing Gullino in view of Chung, and Thrun. The Examiner's purported rejection of claim 8 was superfluous, because claim 8 had been cancelled.

According to the Examiner, Gullino as modified by Chung discloses a top panel 16, a securing device 20, a fluid container support 34 and a syringe 31. The Examiner acknowledged that Gullino does not disclose a first and second top panel hingedly attached and coupled to the housing as recited in claims 2, 3, 7, 9, 10 and 15, nor does Gullino disclose panels in a closed position covering less than one hundred percent of the top opening as recited in claims 7, 9, 10 and 15. The Examiner asserted, however, that Thrun discloses a first and second top panel hingedly attached to the housing and that the panels are selectively positionable to cover at least a portion of the opening, as they can be opened independently of one another. According to the Examiner, Thrun also discloses panels covering less than one hundred percent of the top opening in the closed position.

The Examiner further acknowledged that Gullino does not disclose a syringe cradle, as recited in claims 2, 3, 10, 14 and 15. The Examiner declared that Chung discloses a syringe cradle. The Examiner declared that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Chung to the invention of Gullino, for the reasons discussed above.

The Examiner further declared that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Thrun to the invention of Gullino as modified by Chung, as the purpose of the doors disclosed by Thrun is to allow access to the interior of the enclosure. The Examiner declared that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Thrun to the invention of Gullino as modified by Chung, in order to allow access to the interior of the enclosure without allowing a wide area to possibly permit an animal to escape.

The Applicant incorporates by reference the arguments made and authorities cited above.

The Examiner's purported motivations adding a Thrun device to a Gullino device are not supported by the record. In particular, the Examiner's assertion that modifying a Gullino device with a Thrun device would "allow access to the interior of the enclosure without allowing a wide area to possibly permit an animal to escape" is not supported by the record. It is certainly not supported by Thrun and Gullino. Instead, this is an example of the Examiner lifting an advantage from the Applicant's own disclosure (page 2, lines 6-9, 16-17) and improperly using it against the Applicant.

Claim 7 recites a housing "sized to receive an animal and to confine the animal during therapeutic treatment." Thrun is not directed to the field of the Applicant's endeavor, nor is Thrun reasonably pertinent to the particular problem with which the Applicant was concerned. Thrun therefore fails the test of In re Oetiker, 24 USPQ2d at 1445. The Thrun device is not directed to a cover for an enclosure or housing used to confine an animal during therapeutic treatment. Rather, Thrun is directed to a cover for an enclosure to hold a pet such as a ferret, hamster, gerbil, snake, chameleon, insect or arachnid. Thrun col. 1., lines 18-24. In other words, the Thrun device is a cover designed for an enclosure in which an animal lives on a day-to-day basis, not an enclosure in which an animal is confined during therapeutic treatment.

There is no mention in Thrun of animal sickness, treatment or therapy. On the contrary, a pet in an enclosure described by Thrun, unlike an animal receiving therapy, is given considerable freedom of movement. Moreover, a pet in an enclosure described by Thrun is, when the doors are closed, isolated from the outside world. The Thrun device is, in normal use, completely closed to prevent animal escapes. The Applicant's claimed device, by contrast, balances animal confinement with simultaneous access to the animal by the caregiver. As will be discussed in more detail below, the Thrun device does not accommodate this balance. One skilled in the art would not look to Thrun for a cover for a housing that confines an animal during therapeutic treatment.

When the above argument was presented to the Examiner, the Examiner deemed it an admission that Thrun was analogous art:

In response to the applicant's argument that the Thrun reference is concerned with daily living of an animal but the applicant's is concerned with living in the enclosure during therapy.

[sic] The examiner maintains that this is an admission by the applicant that they are related and relevant art. The animal is living in both the devices and the amount of time spent in them is never claimed. Also both may be opened and closed at some point in the animals [sic] time in the device, it will be confined [sic], it appears that the applicant is more specific than what is claimed. (Detailed Action, p. 4, emphasis supplied)

In spite of the Applicant's argument that "Thrun is not directed to the field of the Applicant's endeavor, nor is Thrun reasonably pertinent to the particular problem with which the Applicant was concerned" the Examiner bizarrely deemed this as an admission to the contrary. This was no admission at all, and the Examiner's rationale is nonsense. The issue is not claim scope, but whether Thrun meets the Oetiker standards. Thrun clearly does not. One interested in an animal confinement apparatus that confines the animal during therapeutic treatment and that balances animal confinement with simultaneous access to the animal by the caregiver would not look to Thrun for a cover for a housing.

In connection with top panels for the housing that cover less than 100 percent of the opening when in the closed position, the Applicant focuses upon independent claim 7, and notes that similar arguments may apply to dependent claims 9, 10 and 15 as well.

Independent claim 7 recites an apparatus comprising a housing sized to receive an animal and to confine the animal during therapeutic treatment, wherein the housing defines a top opening. Claim 7 further recites a first top panel hingedly coupled to the housing and a second top panel hingedly coupled to the housing, the first and second top panels being selectively positionable to cover at least a portion of the top opening. Claim 7 further recites that the first and second top panels when in a closed position cover less than one hundred percent of the top opening.

The Examiner asserted that Thrun discloses a first and second top panel hingedly attached to the housing and that the panels are selectively positionable to cover at least a portion of the opening, as they can be opened independently of one another, and also that Thrun also discloses panels covering less than one hundred percent of the top opening in the closed position. The Examiner cited, as support for this assertion, Fig. 5 of Thrun.

The Examiner is incorrect. Thrun does not disclose panels covering less than one hundred percent of the top opening when the panels are in the closed position. None of the Thrun figures depicts doors covering less than 100 percent of the opening when in the closed position. On the contrary, the Thrun figures and text both clearly state that when the doors are in the closed position, the top opening includes no openings that might allow an animal (including a small animal such as an insect) to escape. As noted above, the Thrun device, when the doors are closed, isolates the animal from the outside world to prevent animal escapes. E.g. Thrun col. 4, lines 4-6 (the device "does not provide an open aperture through which animals may escape"). Unlike the Applicant's claimed device, which balances animal confinement with simultaneous access to the animal by the caregiver, Thrun does not accommodate such a balance. When the Thrun doors are closed, the caregiver has no access to the animal, and the animal has no opportunity to escape.

Claim 3 recites a clasp configured to secure a top panel in a closed position. (Claim 3 depends upon claim 2, which recites a first top panel and a second top panel hingedly coupled to a housing, the panels being selectively positionable. Claim 2 depends upon claim 1, discussed above.) The Examiner rejected claim 3, asserting that Gullino discloses a securing device 20, which holds the unit (presumably the Examiner intended to refer to cover 16) in place by a gripping means. Gullino, however, does not disclose a clasp. Items 20 are screw devices that "firmly anchor the base 12, the wire mesh screen 13, and the four walls 14 together" (Gullino col. 2, lines 44-46). Screw devices 20 do not couple to cover 16, and do not secure cover 16 in a closed position. Moreover, cover 16 is not hingedly coupled to a housing and selectively positionable, as required by claim 3. The Examiner's reliance upon Gullino is for rejection of claim 3 is was clearly erroneous.

Because the rejections of claims 3, 7, 9, 10 and 15 under 35 U.S.C. § 103(a) were erroneous, the Applicant respectfully request that the rejection of these claims be reversed.

#### *Claim 6*

In the Final Office Action, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Gullino in view of Chung, and further in view of Peterson (US 5,988,110). The Examiner asserted that Gullino discloses a window 14.

The Examiner acknowledged that Gullino does not disclose a grate, but declared that Peterson teaches a grate (column 2, line 55). The Examiner declared that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Peterson to the invention of Gullino as modified in order to create a cage which would not restrict airflow to the animal.

The Applicant incorporates by reference the arguments made and authorities cited above.

Once again, the record is devoid of any evidence supporting a motivation to add a Peterson feature to a Gullino device. Gullino does not disclose a window, but rather discloses a cage made of a clear material such as plexiglass (Gullino col. 2, lines 17-20, Figs. 1-2). Peterson does not disclose a grate on a window, but rather discloses a cage made of rectilinear wire mesh (Gullino col. 2, lines 54-55). Even if Gullino did disclose a window and even if Peterson did disclose a grate, one skilled in the art would not be motivated to add a Peterson structure to a Gullino device. One skilled in the art would not combine a piece of transparent material such as plexiglass with wire mesh to create a window covered by a grate. Such a combination would not result in the benefit identified by the Examiner, i.e., a cage that would not restrict airflow. Placing a wire mesh on a piece of plexiglass does nothing to affect the airflow. There would be no motivation for one skilled in the art to do any such thing. Even if one skilled in the art were to do so, however, the Applicant's claimed invention would not result.

Claim 6 recites that front panel that defines a window. In other words, claim 6 recites a front panel and a window as distinguishable structures, with the window being defined by the front panel. The Examiner asserted that the structure in Gullino numbered 14 is both a panel and a window. Thus, Gullino does not disclose a distinguishable panel and window, as recited in claim 6.

Claim 6 further recites a grate covering the window. In other words, claim 6 recites a front panel, a window and a grate as distinguishable structures. Peterson describes a cage wire mesh, not a grate as recited in claim 6. The mesh in Peterson does admit air, but it does not block a passage such as window. Nor is the Peterson mesh distinguishable from a panel. On the contrary, the mesh in Peterson serves the same function as a panel. Combining a Gullino plexiglass panel with a Peterson wire mesh panel would not produce the Applicant's invention as recited in claim 6, i.e., an

apparatus comprising a front panel that defines a window, and further comprising a grate covering the window.

As noted above, claim 6 depends on claim 1. Because the rejection of claim 1 should be reversed, the rejection of claim 6 should also be reversed. Because the rejection of claim 6 under 35 U.S.C. § 103(a) was erroneous, the Applicant respectfully request that the rejection of claim 6 be reversed.

*Claims 16-19*

The Examiner also rejected claims 16-19 under 35 U.S.C. § 103(a) as being unpatentable over Gullino in view of Chung, and further in view of Carlin (US D297,471). The Examiner declared that Gullino as modified by Chung discloses a housing with a syringe cradle attached, and a fluid container support. The Examiner conceded that Gullino as modified does not disclose a post as recited in claims 16 and 18, nor does Gullino as modified disclose a crook-shaped fluid container support as recited in claims 17 and 19. The Examiner declared that Carlin discloses a post and a crook-shaped support. The Examiner further declared that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Carlin to the invention of Gullino as modified in order to provide a secure means of support for the syringe cradle which would be out of reach of the animal being treated, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Carlin to the invention of Gullino as modified in order to hold items in a secure and stable position. The Examiner also declared that “a crook-shaped pole is well-known to be used in therapeutic treatment settings such as this one.”

The Applicant incorporates by reference the arguments made and authorities cited above.

Once again, there is no evidence in the record to support a motivation to combine a Carlin device with a Gullino device. The Examiner rejected dependent claims 16-19, based upon Gullino as modified by Chung and Carlin. Claims 16 and 17 depend on independent claim 1, and claims 18 and 19 depend on independent claim 11. Claims 16 and 18 recite a post coupled to the housing, the post supporting the syringe cradle. Claims 17 and 19 recite a fluid container support that is crook-shaped.

Carlin is a design patent with no descriptive text, other than "The ornamental design for an animal cage-mounted support." Carlin does seem to be directed to the Applicant's field of endeavor, but the Examiner still has no evidentiary basis for adding features of the Carlin device to the Gullino device.

In re Lee, 61 USPQ2d at 1433 and other legal authorities mandate that there must be a reason or motivation for making adding Carlin features to a Gullino device. There is none. Adding a Carlin device to the Gullino device would merely be adding superfluous or redundant features, and one skilled in the art would not be motivated to add superfluous or redundant features.

There is no motivation to modify the Gullino device by adding a post as disclosed by Carlin, plus a Chung clamping frame. As already noted, there is no syringe disclosed by Gullino. Consequently, coupling a Chung device to a Gullino device would be completely superfluous. It follows that coupling a Chung device and a Carlin device to a Gullino device would be just as superfluous. There would be no motivation for a person skilled in the art to attach a post to the Gullino device to support a syringe cradle that itself is not needed with the Gullino device.

Similarly, there would be no motivation to modify the Gullino device by adding a crook-shaped fluid support. Gullino discloses a water bottle 33 secured with a securing strap 34. Gullino col. 3, lines 32. The Examiner has identified securing strap 34 with a "fluid container support." Because bottle 33 is held by strap 34, adding a crook-shaped Carlin device as a fluid container support would serve no purpose. There is no indication in Gullino that a second fluid container support would be desirable (i.e., a crook-shaped support and a strap), nor is there any hint in Gullino that a crook-shaped support could replace strap 34, nor is there any suggestion in Gullino that bottle 33 could be suspended from a crook-shaped support. Accordingly, one skilled in the art would not be motivated to add Carlin features to a Gullino device.

Clearly, the Examiner has taken elements from different references and tried to reconstruct the Applicant's claimed invention from those elements. This is plainly a reconstruction of the claimed invention from hindsight, and such reconstruction is plainly improper under the legal authorities cited above.

As noted above, claims 16 and 18 depend on claim 1, and claims 18 and 19 depend on claim 11. Because the rejections of claims 1 and 11 should be reversed, the

rejections of claim 16-19 should also be reversed. Because the rejections of claims 16-19 under 35 U.S.C. § 103(a) was erroneous, the Applicant respectfully request that the rejections of claims 16-19 be reversed.

### CONCLUSION

For the reasons given above, rejection of claims 1-3, 6-7, 9-11 and 14-19 under 35 U.S.C. § 103 were erroneous and should be reversed. The Examiner applied improper legal standards in rejecting the Applicant's claims. In addition, the record lacks evidence to support a motivation to combine features from one reference with features from any other reference. Furthermore, the references, taken as a whole, do not suggest the claimed subject matter. The Examiner has failed to meet the burden of establishing a prima facie case of obviousness for all pending claims. In view of Appellants' arguments, the final rejections of claims 1-3, 6-7, 9-11 and 14-19 are improper and should be reversed.

Respectfully submitted,

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## APPENDIX: CLAIMS ON APPEAL

1. An apparatus comprising:  
a housing comprising a front panel, a rear panel, a bottom panel, and two side panels, the housing being sized to receive an animal; and  
a fluid container support coupled to the housing; and  
a syringe cradle coupled to at least one of the housing and the fluid container support.
2. The apparatus of claim 1, further comprising:  
a first top panel hingedly coupled to the housing; and  
a second top panel hingedly coupled to the housing,  
wherein the housing defines a top opening and the first and second top panels are selectively positionable to cover at least a portion of the opening.
3. The apparatus of claim 2, further comprising a clasp, the clasp configured to secure a top panel in a closed position.
6. The apparatus of claim 1, wherein front panel defines a window, the apparatus further comprising a grate covering the window.
7. An apparatus comprising:  
a housing sized to receive an animal and to confine the animal during therapeutic treatment, wherein the housing defines a top opening;  
a first top panel hingedly coupled to the housing; and  
a second top panel hingedly coupled to the housing, the first and second top panels being selectively positionable to cover at least a portion of the top opening;  
wherein the first and second top panels when in a closed position cover less than one hundred percent of the top opening.
9. The apparatus of claim 7, further comprising a fluid container support coupled to the housing.

10. The apparatus of claim 7, further comprising a syringe cradle coupled to the housing.
11. An apparatus comprising:
  - a housing sized to receive an animal and to confine the animal during therapeutic treatment; and
  - a fluid container support coupled to the housing; and
  - a syringe cradle coupled to at least one of the housing and the fluid container support.
14. The apparatus of claim 11, further comprising a top panel hingedly coupled to the housing.
15. The apparatus of claim 11, wherein the housing defines a top opening and wherein the top panel is a first top panel, the apparatus further comprising:
  - a second top panel, the first and second top panels configured to assume a closed position in which a portion of the top opening is covered, and further configured to cover less than one hundred percent of the top opening.
16. The apparatus of claim 1, further comprising a post coupled to the housing, the post supporting the syringe cradle.
17. The apparatus of claim 1, wherein the fluid container support is crook-shaped.
18. The apparatus of claim 11, further comprising a post coupled to the housing, the post supporting the syringe cradle.
19. The apparatus of claim 11, wherein the fluid container support is crook-shaped.